

REMARKS

In the Office Action dated June 24, 2005, claims 1-26 were presented for examination. The Examiner rejected claims 1-26 under 35 U.S.C. §103(a).

Applicant wishes to thank the Examiner for the careful and thorough review and action on the merits in this application. The following remarks are provided in support of the pending claims and responsive to the Office Action of June 24, 2005 for the pending application.

I. Rejection of claims 1-26 under 35 U.S.C. §103(a)

Claims 1-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Moore et al.* (U.S. Patent Publication No. 2004/0133609) in view of *Logue et al.* (U.S. Patnt No. 6,647,421).

Applicant's remarks to the *Moore et al.* publication '609 and the *Logue et al.* patent '421 provided in the response to the First Office Action are hereby incorporated by reference.

With respect to claim 1, the Examiner combines *Moore et al.* with *Logue et al.* to teach all of the elements in the claim. As noted by the Examiner, *Moore et al.* does not teach or suggest use of an administrator to launch a low priority task in an aspect of spawning a lower priority task from a higher priority task. The Examiner uses *Logue et al.* to support use of an administrator component. However, the *Logue et al.* patent does not pertain to the claimed subject matter, namely spawning a lower priority task from a higher priority task. The Court of Appeals for the Federal Circuit has long held that “[i]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)). Yet that is the very process that the Examiner has undertaken. *Logue et al.* does not show teach or suggest implementing their administrator for spawning a lower priority task from a higher priority task. Courts have long recognized that most patents may be considered combination patents in which different elements are combined from prior art to achieve a new and useful apparatus and/or method. The Court of Appeals for the Federal Circuit has stated that:

If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed invention would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'

In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) (citing *Sensonics, Inc. Aerosonic Corp.*, 81 F.2d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996)). In the present case, as one would naturally expect, the Examiner is finding some of the elements of Applicant's invention in various prior art patents. However, the Examiner goes further in the present case by then using the Applicant's claimed invention as a template to combine the elements found in the prior art in a way neither found in the prior art nor even functional in the prior art. It speaks to the novel nature of Applicant's invention that when Applicant's claimed invention is viewed in its entirety it is greater than the sum of its parts and combines to form an invention that produces an improvement over the prior art systems. Accordingly, the Applicant respectfully contends that the combination of *Moore et al.* in view of *Logue et al.* does not, and can not, meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests the removal of the rejection of claims 1-26.

In the Office Action dated June 24, 2005, the Examiner responds to Applicant's argument and states that "the motivation for the rejection is found in the knowledge generally available to one of ordinary skill in the art." However, such a motivation is improper. As the MPEP makes clear, "**it is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.**" MPEP §2144.03, citing *Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 1996). "As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support." *Id.* at 1385, 59 USPQ 2d at 1697. See also *In re Lee*, 277 F.3d 1338, 61 USPQ 1430 (Fed. Cir. 2002). Yet, according to the Office Action dated June 24, 2005, this is exactly what the Examiner is doing. Accordingly, Applicant respectfully requests the Examiner to remove the rejection of claims 1-26.

With respect to the "flag" as noted in claims 5-7, 15-17, 22, 23, and 25, the prior art does not teach use of a flag associated with the task of launching a lower priority task, as noted by the Examiner on page 10, paragraph 27, in the Office Action dated June 24, 2005. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Although, assuming for purposes of this discussion that it may be "obvious" to modify *Moore et al.* to incorporate a "flag" for the purpose claimed by Applicant, *Moore et al.* does not teach a flag for differentiating and handling request priorities. The prior art must teach all of the elements in the claims. *Moore et al.* teaches use of a flag for other aspects of their invention, but not for differentiating among requests. If *Moore et al.* had wanted to use a flag for differentiating among tasks, then *Moore et al.* would have done so. The fact that *Moore et al.* does not use a flag for the use claimed by Applicant should serve as evidence that *Moore et al.* does not teach or suggest this claimed limitation. Accordingly, Applicant respectfully requests allowance of claims 5-7, 15-17, 22, 23, and 25.

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

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